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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,597	02/07/2001	Melinda Earl Gibbs	20010001.US	7646

7590

04/01/2002

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EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

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DATE MAILED: 04/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-5

Office Action Summary	Application No.		Applicant(s)	
	09/778,597		GIBBS, MELINDA EARL	
	Examiner		Art Unit	
	Jerry A. Lorengo		1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-27 is/are pending in the application.

 4a) Of the above claim(s) 16-19 and 24-27 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-15 and 20-23 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) ☐ All b) ☐ Some * c) ☐ None of:

 1. ☐ Certified copies of the priority documents have been received.

 2. ☐ Certified copies of the priority documents have been received in Application No. _____.

 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other:

DETAILED ACTION

(1)

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 and 20-23, drawn to a method of creating a transfer image, classified in class 156, subclass 240.
- II. Claims 16-19, 24 and 27, drawn to a product and product by process, classified in class 428, subclass 15.
- III. Claims 25-26, drawn to a kit, classified in class 283, subclass 45.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the formation of the decorative layers on the substrate via spraying and painting.

Inventions II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a transfer sheet which can be used simply as such and a waterfast ink which may find use in producing printed documents and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another

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materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as using the transfer sheet to make a simple transparency and utilizing the waterfast ink to produce printing on a sheet of paper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Lawrence Crowe on March 12, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15 and 20-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 and 24-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

(2)

Claim Objections

Applicant is advised that should claim 1 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 11 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is not understood by the examiner how the occupation of the person practicing the method further limits the method as disclosed in applicant claim 10.

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(3)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 12 are indefinite because it is not understood by the examiner how the occupation of the person practicing the method of claim 10 has anything to do with its actual practice.

Claim 11 recites the limitation "said selecting" in line 2. There is insufficient antecedent basis for this limitation in the claim. It also appears that applicant claim 11 should properly depend from applicant claim 10 instead of applicant claim 8. It has been assumed for examination purposes that claim 11 depends from applicant claim 10.

(4)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent No. 6,153,038 to Brooker.

Regarding applicant claim 20, Brooker discloses a method for v=creating an image adapted for transfer comprising the steps of:

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(1) Forming an image by applying a first layer of a waterfast (non-water soluble) medium to a surface of an ink-jet transparency sheet having a coating on one surface thereof adapted to receive hydrophilic solvent-based inks (column 2, lines 43-52; column 4, lines 58-64; column 7, lines 39-48).

(5)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 13-15 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,153,038 to Brooker in view of U.S. Patent No. 4,770,732 to Steelman.

Regarding applicant claims 1, 20 and 21, Brooker discloses a method of transferring images to substrates comprising the steps of:

(1) Forming an image by applying a first layer of a waterfast (non-water soluble) medium to a surface of an ink-jet transparency sheet having a coating on one surface thereof adapted to receive hydrophilic solvent-based inks (column 2, lines 43-52; column 4, lines 58-64; column 7, lines 39-48);

(2) placing the surface of the printed ink-jet transparency in contact with the surface of a substrate to be decorated for an amount of time sufficient to bond and transfer the waterfast image to the surface of the substrate sheet (column 2, lines 53-55); and

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(3) peeling away the transparency sheet (column 5, lines 7-8).

Regarding applicant claim 2, Brooker discloses that the image medium is applied by way of an ink-jet printer (column 7, lines 9-37).

Regarding applicant claim 3, Brooker discloses that the image medium may be in the form of a waterfast ink (column 7, lines 9-48).

Regarding applicant claims 4 and 8, Brooker discloses that a second layer of waterfast ink medium may be applied to the first layer of waterfast medium (column 6, lines 45-61).

Regarding applicant claims 6, 13, 14 and 23, Brooker discloses that the image may be modified by applying additional medium (varnish) onto the image and substrate after the transparency has been peeled wherein the medium (varnish) is different from the first layer (the inkjet printed waterfast ink) of waterfast medium (column 5, lines 29-54).

Regarding applicant claim 15, Brooker discloses that the substrate may comprise virtually any material including fabricated substrates such as glass, metal, ceramics, vinyl, self-adhesive vinyl, paint, paper and cardboard (column 3, lines 1-3).

Although Brooker discloses the overall process for the printing and transfer of waterfast ink-jet images from an ink-jet transparency sheet to the surface of a substrate, he does not specifically disclose, as per applicant claims 1, 21 and 22, the use of a solvent applied either to the image on the transparency or to the surface of the target substrate to at least partially liquefy the image layer.

It would have been obvious to one of ordinary skill in the art at the time of invention to activate the waterfast image on the transparency sheet of Brooker through the application of a solvent to either the imaged transparency and/or to the surface of the target substrate motivated by the fact that Steelman, also drawn to methods for the application and transfer of waterfast ink images from a plastic substrate to a target substrate, discloses that it is known to do so and is useful in activating the ink and permitting the graphics to be transferred to a display surface (Figures 1-2; abstract; column 4, lines 21-46).

Although Brooker discloses that the medium may additionally comprise non-waterfast medium (column 7, lines 9-37), he does not disclose, as per applicant claims 5, 7, 8 and 9, the specific opacity or transparency of the waterfast medium applied to the transparency or the specific modifications carried out on the imaged transparency. Brooker also does not specifically

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disclose, as per applicant claim 10, the creation of several alternate images or separate transparency sheets or that the method is practiced and images are selected by persons having particular occupations.

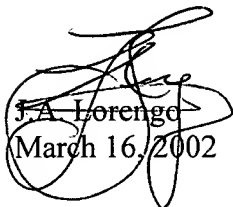
Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the imaged transparency through the addition of various transparent and colored layers with mediums having different chemical or physical properties motivated by the fact that Brooker discloses that manipulation of the image can include adjustment of the brightness, colors, orientation, size, background, foreground, shapes and various other visual effects (column 3, lines 20-23) and furthermore by the fact that such modification would have been the result of routine experimentation by one of ordinary skill based upon a consideration of the materials worked with as well as overall design choice.

(6)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J.A. Lorengo
March 16, 2002